

Claims 1-28 remain pending and under examination.

In the Office Action,<sup>1</sup> the Examiner rejected claims 1-7, 10, 12-21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,697,099 to Smith et al. (“*Smith*”) in view of U.S. Patent No. 6,556,590 to Saeijs et al. (“*Saeijs*”), and further in view of U.S. Patent No. 6,449,352 to Takahashi et al. (“*Takahashi*”); and rejected claims 1, 8, 9, 11, 15, 22, 23, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of U.S. Patent No. 5,786,845 to Tsuria (“*Tsuria*”), and further in view of U.S. Patent No. 6,529,246 to Maeda (“*Maeda*”) and *Takahashi*.

Applicant respectfully traverses the Examiner’s rejections for the following reasons.

**I. The rejection of claims 1-7, 10, 12-21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of *Saeijs*, and further in view of *Takahashi* is improper.**

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-7, 10, 12-21, and 24 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In*

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

*re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, none of *Smith*, *Saeijs*, or *Takahashi*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claim 1, for example, recites a combination including:

a detection step of detecting the timing of inserting discontinuity information data into contents of the data on said electronic equipment to be recorded and/or reproduced ...; and

a step of inserting said discontinuity information data into said data on detection of the timing of inserting the discontinuity information data in said detection step,

wherein said discontinuity information data contains at least an indication of a status change of content and position within a source data, and

wherein said detection step detects the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents

(emphasis added).

The Examiner concedes that *Smith* does not teach or suggest at least these elements (Office Action at p. 2). Further, the Examiner concedes that *Saeijs* does not teach or suggest at least "wherein said detection step detects the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents," as recited by claim 1.

Nevertheless, the Examiner asserts that *Takahashi* "teaches the capability of adding a reference time signal continuous flag showing that the reference time signal is not continuous (corresponding to change identifier) ... (see col. 4, lines 35-44 and col.

5, lines 52-60)" (Office Action at p. 4). Even assuming the Examiner's assertion is true, *Takahashi's* reference time signal continuous flag does not constitute a teaching or suggest of detecting "the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents," as recited by claim 1. Indeed, *Takahashi* fails to mention the operation mode, timing change, content change, and transition point as claimed.

Because neither *Smith*, *Saeijs*, nor *Takahashi*, taken alone or in combination, teaches or suggests each and every element recited by claim 1, no *prima facie* case of obviousness has been established with respect to this claim.

Moreover, the Examiner has not shown any motivation in the cited references to modify *Smith* with *Saeijs*, and further with *Takahashi* to produce the claimed invention. None of *Smith*, *Saeijs*, or *Takahashi* teaches or suggests motivation to insert "discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents," as recited by claim 1. Therefore, one of ordinary skill in the art would not turn to *Smith*, *Saeijs*, or *Takahashi* to develop at least this aspect of Applicants' claimed invention. For at least this additional reason, no *prima facie* case of obviousness has been established.

Accordingly, Applicant respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of *Saeijs*, and further in view of *Takahashi*.

Independent claims 12 and 15, although of different scope, recite similar elements to independent claim 1. Claims 2-7, 10, 13, 14, 16-21, and 24 depend from

independent claims 1, 12, and 15 and therefore include all of the elements recited therein. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established with respect to claims 2-7, 10, 13-21, and 24. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claims 2-7, 10, 12-21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Smith*, in view of *Saeijs*, and further in view of *Takahashi*.

**II. The rejection of claims 1, 8, 9, 11, 15, 22, 23, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view *Tsuria*, and further in view of *Maeda* and *Takahashi* is improper.**

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 8, 9, 11, 15, 22, 23, and 25-28 because a *prima facie* case of obviousness has not been established with respect to these claims. A *prima facie* case of obviousness has not been established because, among other things, neither *Smith*, *Tsuria*, *Maeda*, nor *Takahashi*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

As noted above, claim 1, for example, recites a combination including:

a detection step of detecting the timing of inserting discontinuity information data into contents of the data on said electronic equipment to be recorded and/or reproduced ...; and

a step of inserting said discontinuity information data into said data on detection of the timing of inserting the discontinuity information data in said detection step,

wherein said discontinuity information data contains at least an indication of a status change of content and position within a source data, and

wherein said detection step detects the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents

(emphasis added).

The Examiner concedes that *Smith* does not teach or suggest at least these elements (Office Action at p. 8). Nevertheless, the Examiner asserts that "*Tsuria* teaches a detection step for detecting the timing of inserting discontinuity information data into contents of the data (detecting the zapping periods disclosed in col. 3, lines 54-65 and col. 1, lines 16-24)" (Office Action at p. 8). The Examiner also asserts that "[t]he 'zapping time' of *Tsuria* anticipates the claimed 'discontinuity data'" (Office Action mailed March 24, 2005, at p. 3). Applicant respectfully submits that these assertions are incorrect.

The zapping periods of *Tsuria* are merely "delays involved in tuning the decoder" (emphasis added, *Tsuria*, col. 1, lines 21-22). These delays are a function of the tuner, and do not constitute a teaching or suggestion of "discontinuity information data [inserted] into contents of the data," as recited by claim 1. Therefore, even assuming *Tsuria* teaches "detecting zapping periods," this does not constitute a teaching or suggestion of a "detection step of detecting the timing of inserting discontinuity information data into contents of the data on said electronic equipment to be recorded and/or reproduced," (emphasis added) as recited by claim 1.

Further, the Examiner asserts that *Tsuria* teaches the claimed

step of inserting said discontinuity information data into said data on detection of the timing of inserting the discontinuity information data in said detection step, wherein said discontinuity information data contains at least an indication of a status change of content and position within a source data,

as recited by claim 1, by "displaying advertisement data during zapping periods disclosed in col. 3, lines 54-65." The Examiner has not made clear how *Tsuria*'s

teaching of “advertisement data” allegedly relates to elements recited by claim 1. Assuming that *Tsuria*’s “advertisement data” allegedly constitutes the claimed “discontinuity information data,” this allegation is incorrect. *Tsuria* teaches “[d]uring zapping periods, processor 28 is operable to retrieve the advertisement data from memory and to provide it … for display” (*Tsuria*, col. 3, lines 61-64). That is, *Tsuria* displays advertisement data during the delay “involved in tuning the decoder” (*Tsuria*, col. 1, lines 21-22). Neither the *Tsuria*’s “zapping periods,” nor *Tsuria*’s “advertisement data,” are inserted as “discontinuity information data into said data …, wherein said discontinuity information data contains at least an indication of a status change of content and position within a source data,” as recited by claim 1.

Further, the Examiner concedes that *Tsuria* does not teach or suggest at least “wherein said detection step detects the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents,” as recited by claim 1 (Office Action at p. 9).

The Examiner asserts that *Maeda* “teaches that the inserting a channel number during zapping periods can be applied not only to a video cassette recorder but also to a television set or the like (col. 6, lines 43-67)” (Office Action at p. 9). The Examiner has not made clear how this assertion relates to claim 1. Indeed, although the Examiner makes the above assertion, the Examiner concedes that *Maeda* does not teach or suggest at least detecting “the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents” (Office Action at p. 10).

Nevertheless, the Examiner asserts that *Takahashi* teaches “a reference time signal continuous flag” (Office Action at p. 10). As discussed above, even assuming the Examiner’s assertion is true, *Takahashi*’s reference time signal continuous flag does not constitute a teaching or suggest of detecting “the timing of inserting discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents,” as recited by claim 1.

Because neither *Smith*, *Tsuria*, *Maeda*, nor *Takahashi*, taken alone or in combination, teaches or suggests each and every element recited by claim 1, no *prima facie* case of obviousness has been established with respect to this claim.

Moreover, the Examiner has not shown any motivation in the cited references to modify *Smith* with *Tsuria*, and further with *Maeda* and *Takahashi* to produce the claimed invention. None of *Smith*, *Tsuria*, *Maeda*, or *Takahashi* teaches or suggests motivation to insert “discontinuity information data in accordance with a change in an operation mode, a timing change, a content change, and a transition point in digital contents,” as recited by claim 1. Therefore, one of ordinary skill in the art would not turn to *Smith*, *Tsuria*, *Maeda*, or *Takahashi* to develop at least this aspect of Applicants’ claimed invention. For at least this additional reason, no *prima facie* case of obviousness has been established.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Smith* in view of *Tsuria*, and further in view of *Maeda* and *Takahashi*.

Independent claims 15 and 26, although of different scope, recite similar elements to independent claim 1. Claims 8, 9, 11, 22, 23, 25, 27, and 28 depend from

independent claims 1, 15, and 26 and therefore include all of the elements recited therein. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established with respect to claims 8, 9, 11, 15, 22, 23, and 25-28. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claims 8, 9, 11, 15, 22, 23, and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over *Smith*, in view of *Tsuria*, and further in view of *Maeda* and *Takahashi*.

### III. Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 7, 2005

By:   
Nathan A. Sloan  
Reg. No. 56,249  
202.408.4312